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In re Application of
OMARRSON
Application No.: 09/720,833
PCT No.: PCT/IB99/01214
Int. Filing Date: 28 June 1999
Priority Date: 01 July 1998
Attorney Docket No.: 918-002
For: FUEL-AIR MIXTURE APPARATUS

DECISION ON PETITION
UNDER 37 CFR 1.137(a)

This is a decision on applicant's petition under 37 CFR 1.137(a) filed in the United States Patent and Trademark Office (USPTO) on 05 March 2001.

BACKGROUND

On 28 June 1999, applicant filed international application No. PCT/IB99/01214 which claimed a priority date of 01 July 1998, and which designated the United States.

On 28 January 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for entry into the national stage in the U.S. was extended and expired 30 months from the priority date, i.e. 02 January 2001 (01 January 2001 was a federal holiday).

On 28 December 2000, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, authorization to charge the \$930 basic national fee to applicant's deposit account (no.19-2825). However, there were insufficient funds in applicant's deposit account to pay the basic national fees and as a result, the application went abandoned.

On 26 January 2001, applicant provided a Declaration and Power of Attorney executed by the inventor along with authorization to charge deposit account no.19-2825 the surcharge for filing the declaration after the thirty month period.

On 05 February 2001, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to provide the basic national fee by the 30 month deadline.

On 05 March 2001, applicant filed the present petition requesting that the application be revived since the abandonment was unavoidable on the grounds that the deficiency in applicant's deposit account was the result of "several mistakes [that] were made on the part of the United States Patent and Trademark Office, such as overcharging and unauthorized withdrawals, which could not have been reasonably anticipated by us on or before December 28, 2000". Applicant acknowledges that the balance was lower than anticipated and that "there were insufficient funds in the account to cover the Basic National Fee of \$930".

DISCUSSION

PETITION TO REVIVE UNDER 37 CFR 1.137(a)

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay is required to be filed promptly after applicant became aware of the abandonment. Such petition is required to be accompanied by (1) a proper response, unless already filed, (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable, (3) the petition fee required by law, and (IV) a terminal disclaimer and fee where the application was filed before 08 June 1995.

A review of the finance records for this application indicate that applicant has satisfied Item (1) above, with the payment of the basic national fee of \$860. As for Item (3), the requisite petition fee of \$55.00 has been paid. Thus, Items (1) and (3) above have been satisfied. With regard to item (4), a terminal disclaimer and fee is not required in this case since the application was filed after 08 June 1995.

Concerning item (2), applicant has urged that the delay in paying the basic national fee was the result of a deficiency in applicant's deposit account due to USPTO mistakes, "such as overcharging and unauthorized withdrawals, which could not have been reasonably anticipated by us on or before December 28, 2000".

In support of his petition, applicant submitted the affidavit of his attorney, Joseph Sofer, in an attempt to explain the "discrepancies where overcharged or unauthorized withdrawals were made against Deposit Account 19-2825" which applicant claims reduced the balance below the law firm's reasonable expectation. (¶7) In ¶8, Mr. Sofer references three (3) U.S. applications handled by the law firm, where the alleged incorrect or unauthorized charges to the firm's deposit account were incurred causing the deficiency in the present application. Mr. Sofer notes that the redacted information regarding the three applications is intended to preserve the clients' confidentiality. The following is a discussion of the one of the three applications specifically relied upon in Mr. Sofer's affidavit.

Attorney Docket No. 655-012 Referenced in Sofer Affidavit ¶8(C)

In the application represented by attorney docket no. 655-012, counsel argues that the USPTO charged the issue fee of \$1240 to deposit account no. 19-2825 on the date that the fees were due (12/18/00), in spite of the fact that a check for the amount of \$1210 had allegedly been provided with the filing. Counsel provided a copy of the check with part of the application number handwritten upon it. Counsel did not provide a copy of the canceled check and states that he checked with the law firm's bank on February 13, 2001 and the check [#5130] in the amount of \$1210 is still outstanding.

Counsel also provided a copy of the postcard receipt bearing USPTO date-stamp "18

December 2000" and the attorney docket number 655-012. The itemized postcard indicates that a check for \$1210 was included with the Issue Fee Transmittal. The appropriate issue fee is \$1240. However, this is sufficient evidence that applicant provided the funds for the issue fee in the form of a check and would be in reasonable reliance that the check would cover those fees and his deposit account would not be charged the amount of \$1210.

The withdrawal \$1240 from deposit account no.19-2825 by the USPTO in the amount of, although authorized, should not have been necessary, thus causing the deposit account balance to fall below the amount needed to cover the basic national fee of \$860 necessary in the instant application, and the subsequent abandonment.

Given counsel's reasonable reliance on a sufficient balance in his deposit account no.19-2825 to cover the basic national fee in this case, petitioner has met his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 U.S.C. 133 and the petition to revive an application under 37 CFR 1.137(a) can be granted.

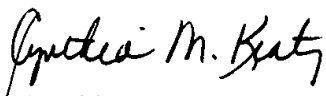
Therefore, since applicant has satisfied item (2) above, the granting of the petition under 37 CFR 1.137(a) for revival based on unavoidable delay is proper.

CONCLUSION

For the reasons above, the petition to revive under 37 CFR 1.137(a) is GRANTED without prejudice.

A review of the application file reveals that the basic national fee of \$840 has been paid. Applicant authorized "any fees or charges...deemed necessary in connection with the application at the present time" to be charged deposit account no.19-2825. The \$65 surcharge for filing the declaration after the thirty month period will be charged to applicant's deposit account no.19-2825. The 35 U.S.C. 371 date for this application is 26 January 2001.

This application is being forwarded to National Stage Processing Branch to continue National Stage processing.



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MEMO

To: Harry Moatz, Office of Enrollment and Discipline
CP6-Room 1103
From: Cynthia M. Kratz *CMK*
Petitions Attorney, PCT Legal Office
Via: Boris Milef, Legal Examiner, PCT Legal Office
Subject: 09/720,833 and 09/731,424
Date: January 7, 2002

Pursuant to the meeting between you and Boris Milef on 20 December 2001, the above identified application files are forwarded to your office for further review.

The facts are as follows:

Attorney of record Joseph Sofer filed a petition under 37 CFR 1.137(a) in 09/720,833 on 05 March 2001 to revive the application based upon unavoidable abandonment. Mr. Sofer argues that in three separate instances, the USPTO overcharged his deposit account which caused a fee deficiency in his account resulting in abandonment of the 09/720,833 application. The petition has been granted on the basis of the third enumerated instance. Troubling, however, is Mr. Sofer's representation with respect to the second enumerated instance, identified on page 3 of the petition (his reference number "655-004c1", which corresponds to U.S. application 09/731,424).

Specifically, Mr. Sofer provided an exhibit, which relates to the 09/731,424 application. The exhibit (Ex.10) is a fee calculation sheet, which indicates that a check in the amount of \$1,884 was enclosed. Mr. Sofer expressly states in his affidavit that "there is no check mark beside the box authorizing the fees to be charged to Deposit Account No.19-2825." (See Sofer affidavit, ¶8B.) However, a review of the original application file for 09/731,424 reveals a discrepancy in the fee calculation sheet. The original fee calculation sheet shows a check mark in the box authorizing the amount to be charged to Mr. Sofer's deposit account and there is no indication that a check for \$1884 was enclosed. The indication of an enclosed check appeared "whited-out" on the original fee sheet.

It is possible that the fee calculation sheet used as an exhibit was altered to lend support to Mr. Sofer's petition.

After your review of the application files, please return the 09/720,833 file to the National Stage Processing Branch of the Office of PCT Operations to continue U.S. processing.